

REMARKS

Amendments

Except as expressly discussed below, any changes made to the Application, including the claims, are not made in Reply to any rejection or other communication from the Examiner, but
5 are made to improve the clarity, readability, or understanding of the application or a portion of the application that was changed. As is evident, none of the foregoing amendments was made to add new matter, and none was made to narrow the scope of the claims. Indeed, all amendments were made merely as cosmetic amendments to improve the readability and coherence of the resulting patent.

Status of Prosecution

10 Claims 1-19 are pending. Claims 7-19 have been withdrawn from examination due to the restriction requirement made final in Office Action No. 2.

Applicants filed the application on December 8, 2003. The Examiner mailed a first, non-substantive, non-final office action on June 18, 2004 directed solely to a restriction requirement.
15 Applicants filed a Response to the restriction requirement on July 7, 2004. The Examiner filed a first substantive office action (referred to in this document as "Office Action No. 2") on September 28, 2004 that both made final the restriction requirement, and included the results of a first substantive examination of the application. This paper is in Reply to the substantive examination. Applicants also have filed with the Director a petition seeking reversal of the
20 restriction requirement, and have provided a copy of the petition to the Examiner.

Applicants request reconsideration and withdrawal of the objections and rejections in Office Action No. 2.

Examiner's General Objections and Rejections

In Office Action No. 2, the Examiner rejected claims 1-5 under 35 U.S.C. §103.

25 In paragraph 6., page 6, of Office Action No. 2, the Examiner stated that claims 1-6 would be allowable, although objected to, if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants are appreciative of the Examiner's indication of allowance, but believe Applicants are entitled to a broader scope of coverage. In addition, in view of the prohibition against unnecessarily making narrowing
30 amendments during prosecution imposed by the several decisions cumulatively referred to as the

Festo Decisions, Applicants submit for the Examiner's consideration that when the Application is considered as whole, the suggested amendments are unnecessary.

In paragraph 2. the Examiner required addition of the continuing data to the specification, and Applicants have amended the specification accordingly.

5 In paragraph 3. the Examiner required claim amendments for clarification, and Applicants have amended the claims accordingly.

In paragraph 4. the Examiner rejected claims 1-5 under 35 U.S.C. §103, an argument that Applicants respectfully traverse.

10 Applicants respectfully urge, therefore, that the objection and rejections of the Examiner be withdrawn.

Rejection under 35 U.S.C. §103(a)

15 In paragraph 4. of Office Action No. 2 the Examiner rejected claims under 35 U.S.C. §103(a) over U.S. Patent No. 6,273,640 issued to Suazo, one of the inventors named in the present application ("Suazo Patent"), in view of U.S. Patent No. 3,446,045 issued to Koch on May 27, 1969 ("Koch Patent"). In response to a predicate observation by the Examiner in connection with the Suazo Patent, Applicants confirm that the Suazo Patent and subject matter of the claims under consider are commonly owned.

20 Applicants submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

25 Specifically, Office Action No. 2 does not state a *prima facie* case of obviousness under 35 U.S.C. §103. On pages 5 and 6 of Office Action No. 2, the Examiner argues that the Koch Patent (a) is a "fluid distribution system" that has "a handle assembly (2) with an anchor means/rod (3) being slidably installed through holes/slots (13), and (b) although "Suezo (sic, "Suazo") fails to specifically disclose the inlet/outlet box, it would have been obvious..." to do so. Accordingly, Office Action No. 2 does not state a *prima facie* case of obviousness under 35 U.S.C. §103. As stated in the MPEP, to establish a *prima facie* case of obviousness, three criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference, or to
30 combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the

cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention...” The Examiner has identified no suggestion or motivation to modify the cited reference, or to combine the teachings in the cited references.

5 A *prima facie* case of obviousness under 35 U.S.C. §103 is not established if references are not properly combinable or modifiable because their intended purpose, intent, or function is destroyed. The Koch Patent is not properly combinable with the Suazo Patent. The purpose, intent, or function of the apparatus of the Koch Patent is to convey water in through a water distribution system mounted above ground, rather than in a liner system installed in an existing
10 ditch below ground, which is the teaching of the Suazo Patent. See Koch Patent, Figure 2, and col. 1, ll. 12-23 (“...having a pair of legs respectively beneath the opposite flanges; and means engageable with the ground to adjustably hold said legs thereby to support the flue at a selected height above the ground.” The “flanges (2)” of the Koch Patent are, therefore, not “handles” as submitted by the Examiner, but are curved extensions to wrap around a curved top of the legs to
15 position the flumes of the Koch Patent above ground.

 Accordingly, although the Examiner asserts that it would be permissible to modify the teachings of Koch to combine elements of the Koch Patent with selected elements of the Suazo Patent, Applicants respectfully submit it is improper to modify the disparate references. The Examiner’s attention is respectfully directed to the last paragraph of MPEP §2143.01, the
20 heading of which states that “The Proposed Modification Cannot change the Principle of Operation of a Reference.” The beginning of this paragraph indicates that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. Clearly, because the Koch Patent teaches a flume system suspended
25 above ground, combining either reference with the other would necessitate a change in the principle of operation of either such other reference. The example provided in MPEP §2143.01 clearly supports Applicants’ position. In that example, the reference required rigidity for operation, whereas the claimed invention required resiliency. In that case, the Court reversed the rejection stating that the “suggested combination of references would require a substantial
30 reconstruction and redesign of the elements shown in [the primary reference] as well as a change

in the basic principle under which the [primary reference] construction was designed to operate.”. The same situation clearly applies to the references cited by the Examiner. Thus, Applicants respectfully submit that modifying either reference in view of the other is improper as provided in MPEP §2143.01.

5 Recent Federal Circuit decisions have amplified the Examiner’s burden of proof and standards for establishing obviousness under §103. The first decision is *In re Debiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); the second is *Ecolochem, Inc. v. Southern California Edison Company*, Fed. Cir. No. 99-1043, September 7, 2000; the third is *In re Sang-su Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434-1435 (CAFC, 2002). These cases remind us that
10 obviousness must be viewed not retrospectively, but solely “at the time the invention was made.” *In re Debiczak*, 50 USPQ2d 1614 at 1617, citing 35 U.S.C. §103. As the Federal Circuit held:

15 Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field...Close adherence to this methodology is especially important in the case of less
20 technologically complex inventions, where the very ease with which the invention can be understood may prompt one to “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.”

In re Debiczak, 50 USPQ2d 1614 at 1617.

25 In addition to reminding that retrospective findings of obviousness are impermissible, the cases also require proof, actual evidence, to support an obviousness rejection. The Federal Circuit emphasized that evidence must support the assertion of a suggestion, teaching, or motivation; if there is no evidence of such a suggestion, teaching, or motivation, it is inappropriate to “make the inventor’s disclosure a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Broad conclusory statements regarding the
30 teaching of multiple references, standing alone, are not “evidence.” *In re Debiczak*, 50 USPQ2d 1614 at 1617 (emphasis added).

 The Federal Circuit went on to explain in *In re Sang-su Lee* that the Board of Patent Appeals and Interferences (“Board”) was incorrect in asserting that “it was not necessary to present a source of teaching, suggestion, or motivation to combine...references to their

5 teachings,” and that it is equally incorrect to assert that a “conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Sang-su Lee*, page 3. Not only were those assertions incorrect, said the Court, the obverse is equally true: “it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.” *In re Sang-su Lee*, page 3. “The factual inquiry whether to combine references must be thorough and searching.” *In re Sang-su Lee*, page 4, citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 101 (Fed. Cir. 2001). In summary, observed the Court, the “need for specificity pervades this authority,” referring to the cases just discussed. *In re Sang-su Lee*, page 6.

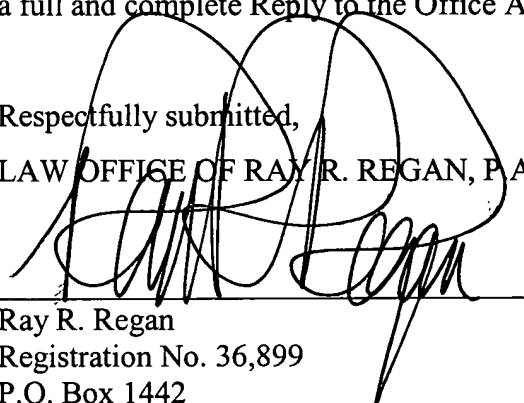
10 Based on those standards, it is clear that nothing in the Koch Patent, in combination with the Suazo Patent, includes a suggestion, teaching or motivation that would have taught a person of ordinary skill in the art to invent what Applicants invented. Nothing in the reference discloses a suggestion or motivation to make the specific combination made by Applicants. Obviousness cannot be established by hindsight combination to produce the claimed invention.

Conclusions

For the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-5.

20 The remaining references cited by the Examiner, but not relied on for the rejection of claims 1-5, have been noted. Because the remaining references are no more pertinent than the applied references, a detailed discussion of these remaining references is deemed unnecessary for a full and complete Reply to the Office Action.

Respectfully submitted,
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